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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,450	09/15/2003	Merja E. Penttila	GC590-2-C1	2737
7590 Genencor International, Inc. 925 Page Mill Road Pola Alto, CA 94034-1013				
EXAMINER				
GUZO, DAVID				
ART UNIT		PAPER NUMBER		
1636				
MAIL DATE		DELIVERY MODE		
09/05/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/663,450

Applicant(s)

PENTTILA ET AL.

Examiner

David Guzo

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 3.5-13, 26-34, 83-85, 87 and 89-99 is/are pending in the application.
- 4a) Of the above claim(s) 83-85 and 87 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 3.5-13, 26-34, 91-94, 98 and 99 is/are rejected.
- 7) ☒ Claim(s) 89, 90 and 95-97 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Action

Election/Restriction

Claims 83-85, 87 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/17/05.

Objections to the Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In original Claim 5, applicants recite that the HAC1 protein is encoded by an isolated nucleic acid isolated from any *Saccharomyces*, *Schizosaccharomyces* or *Kluyveromyces*. However, the specification, as filed only provides support for HAC1 proteins encoded by an isolated nucleic acid from *Saccharomyces cerevisiae*, *Schizosaccharomyces pombe* or *Kluyveromyces lactis*. The specification must be amended to include the subject matter of claim 5.

35 USC 112, 1st Paragraph Rejections

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-3, 5-13, 26-34, 91-94, 98 and 99 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s)

contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants claim a method of increasing the secretion of a heterologous protein in a fungal cell comprising transforming fungal cells with a nucleic acid encoding a fungal HAC1 UPR-modulating protein **comprising a DNA binding domain having the DNA binding domain of amino acid residues 45-109 of SEQ ID NO:19**. Applicants also recite the aforementioned method wherein the UPR-modulating protein **comprises a DNA binding domain having the DNA binding domain of amino acid residues 84 to 147 of SEQ ID NO:5 or amino acid residues 53 to 116 of SEQ ID NO:6**.

The instant claims recite a DNA binding domain **having** (open language, i.e. comprising) the DNA binding domain of the recited portions of SEQ ID NOs 5, 6 or 19. This language reads on a DNA binding domain comprising DNA binding element(s) which include the recited specific residues of SEQ ID NOs 5, 6 or 19 and other unspecified DNA binding domains. The application, as filed does not provide support for this. The application, as filed, provides support for the specific SEQ ID NOs 5, 6 and 19 and the specific residues in said SEQ ID NOs which define the DNA binding domains as well as binding domains having at least 90% identity to the specific DNA binding domains contained in the recited SEQ ID NOs. This is a NEW MATTER rejection.

Claims 89-90 and 95-97 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

No Claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Guzo, Ph.D., whose telephone number is (571) 272-0767. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach, Ph.D., can be reached on (571) 272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 28, 2008

/David Guzo/
Primary Examiner
Art Unit 1636